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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,161	03/07/2000	Tadashi Takahashi	862.C1859	9590

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FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

TRAN, DOUGLAS Q

ART UNIT	PAPER NUMBER
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2624

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DATE MAILED: 10/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/520,161

Applicant(s)

TAKAHASHI, TADASHI

Examiner

Douglas Q. Tran

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/7/00 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-9 and 14-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Satoh et al. (US Patent No. 6,327,600).

As to claim 1, Satoh teaches image processing apparatus comprising:

input means ( 1 in fig. 1) for inputting image data (col. 8, lines 35-36);

detecting means (i.e., the copyright management information check unit 8 in fig. 1) for detecting information relating to a copyright contained in the input image data (col. 5, lines 33-44: the copyright management information check unit 8 for detecting the reference related to the requested document stored in the document storage unit 4);

querying means which, if no information relating to the copyright is detected , is for querying a database as to whether information relating to a copyright corresponding to an image

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represented by the input image data exists in the database (col. 6, lines 4-27: the copyright management information is set or not with respect to a part with reference-reference requested portion or if the reference requested portion is placed in a condition of "reference free"); and

add-on means (i.e., the copyright management information insertion unit 5a in fig. 1) for adding information relating to a copyright, which conforms to the result of querying the data based, onto the input image data (col. 4, lines 19-24: the unit 5a has a function for inserting the copyright management information into the document being presently produced).

As to claim 2, Satoh discloses every feature discussed in claim 1, and further teaches that input means is an image input device (1 in fig. 1).

As to claim 3, Satoh disclose every feature discussed in claim 1, and further teaches display means (2 in fig. 1) for displaying the information relating to the copyright (col. 5, line 65 to col. 6, line 3).

As to claim 4, Satoh discloses every feature discussed in claim 1, and further teaches the querying means transmits the input image data to the database and receives from the database information relating to a copyright corresponding to this input image data (col. 6, lines 10-13).

As to claims 14 and 15, Satoh teaches the method and instruction for performing the apparatus claim 1 as indicated above.

As to claim 5, Satoh discloses a processing method in an apparatus for registering a copyright, comprising the steps of:

receiving a copyright registration request, which is for registering copyright of data, via a network (col. 18, lines 55-60 and col. 19, lines 13-15 shows the application mail would be transmitted to a copyright holder or an agent via the network);

in response to the received copyright registration request, transmitting a registration fee request to a device that issued the copyright registration request (col. 19, lines 13-15);

in response to consent to pay the registration fee (col. 6, lines 31-36), embedding an electronic watermark in the data; and transmitting the data having the embedded electronic watermark to the device (col. 4, lines 19-24: the unit 5a has a function for inserting the copyright management information into the document being presently produced at the print device 9 in fig. 1).

As to claim 6, Satoh discloses every feature discussed in claim 5, and further teaches the copyright registration request includes at least one of a term during which copyright protection of the data is desired, data representing monetary compensation regarding the data, and amount of the data (please see fig. 2).

As to claim 7, Satoh discloses every feature discussed in claim 5, and further teaches a publication fee applies in a case where the data is published on a web page (col. 19, lines 13-15 indicates the communication via the network would inherently includes the internet communication).

As to claim 8, Satoh discloses every feature discussed in claim, and further teaches the publication fee is a fixed rate at start of publication and is decided by number of times the data is distributed data after publication (col. 19, lines 22-28 and fig. 2 indicates that the unit 8 checks each time for request by the user related to the pay fee).

As to claim 9, Satoh disclose every feature discussed in claim, and further teaches the publication fee is a fixed rate at start of publication and is decided by term of publication of the data after publication (note: there inherently is the publication fee would be a fixed rate).

*Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Satoh, in view of claim 5, and in combination with Ikenoue et al. (US Patent No. 5,671,277).

As to claims 10 and 11, Satoh discloses every feature discussed in claim 5.

Although Satoh teaches the printed document includes the related information with the copyright article, Satoh does not teach the electronic watermark, which is invisible or nearly invisible to the eye, includes information indicative of a copyrighted article, a code specific to the copyrighted article, and address information of the apparatus which performed the copyright registration.

Ikenoue teaches the electronic watermark, which is invisible or nearly invisible to the eye, includes information indicative of a copyrighted article, a code specific to the copyrighted article, and address information of the apparatus which performed the copyright registration (col. 6, lines 7-25, table 1 shows a list of the content of the additional data includes information indicative of a copyrighted article, a code specific to the copyrighted article, and address information of the apparatus which performed the copyright registration; the additional data is embedded onto the hard copy "col. 14, lines 26-30).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Satoh in order for the hard copy of the document

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includes the copyright data in the electronic watermark form as taught by Ikenoue. The suggestion for modifying the system of Satoh can be reasoned by one of ordinary skill in the art as set forth above by Ikenoue because such modification prevents the copying against a copyright.

As to claim 12, Satoh and Ikenoue disclose every feature discussed in claim 5, and Ikenoue further teaches steps of storing the data having the embedded electronic watermark; in response to receipt of consent, which is in regard to the compensation request, from the device that issued the distribution request, transmitting the data to the device that issued the distribution request (col. 10, lines 49-60).


As to claim 13, Satoh and Ikenoue disclose every feature discussed in claim 12, and Satoh further teaches in response to distribution of the data, generation of compensation conforming to the data is notified to the device that issued the copyright registration request corresponding to the data (col. 19, lines 6-20).

#### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas Q. Tran whose telephone number is (703) 305-4857 or E-mail address is Douglas.tran@uspto.gov.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Douglas Q. Tran  
Sep. 27, 2003



GABRIEL ROMERO  
PRIMARY EXAMINER